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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/807,712

03/19/2004

Jean-Christophe Bonnain

D-7888

5642

7590

08/24/2005

Tsugihiko Suzuki
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EXAMINER

JARRETT, RYAN A

ART UNIT

PAPER NUMBER

2125

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/807,712

Applicant(s)

BONNAIN ET AL.

Examiner

Ryan A. Jarrett

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant states that Gerber and Bozich et al. fail to disclose actually packaging the at least one object in the package. Examiner agrees, and this is why the GB 2311759 reference was used in a 35 U.S.C. 103(a) rejection. However, Applicant's arguments with respect to the 35 USC 103(a) rejection in view of GB 2311759 are moot since these features are no longer required by the claim language, i.e., the feature of actually packaging the at least one object in the package is no longer required by the claim language.

Examiner does submit however that Gerber (e.g., col. 2 lines 37-46, col. 8 line 53 – col. 9 line 17) and Bozich et al. (e.g., col. 5 lines 28-45, col. 9 lines 8-27) do generate instructions that cause a fabricating device to automatically produce at least part of the package.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the United Kingdom on 9/20/01. It is noted, however, that applicant has not filed a certified copy of the foreign application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 49 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 49 recites that the "output means" communicates the "control data" to the control unit of the fabrication device. But the "outputs means" is a part of the client device, per claim 47, whereas the "control data" is generated at the remote server. So it is not clear how the output means could communicate the control data.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international a application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 39-65 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Bozich et al. U.S. Patent No. 6,748,285 Bozich et al. discloses a client-server arrangement configured to design a package for at least one object and automatically produce at least part of the package (e.g., Figs. 1-9, col. 3 lines 35-49, col. 3 line 66 – col. 4 line 15, col. 4 lines 39-49, col. 5 lines 28-55, col. 6 lines 4-14, col. 6 lines 55-56, col. 7 line 28 – col. 8 line 37, col. 9 lines 8-27).

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7. Claims 39-41, 43, 44, 46-50, 52, 53, 55-57, 59-63, and 65 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Gerber U.S. Patent No. 6,689,035. Gerber discloses a client-server arrangement configured to design a package for at least one object and automatically produce at least part of the package, including generating control data for a cutting machine capable of cutting a package blank and generating control data for controlling a printing device being arranged to apply user-defined printed matter to material for use in forming a package blank (e.g., col. 5 lines 45-62, col. 6 lines 36-53, col. 8 line 5 – col. 9 line 33).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 42, 45, 51, 54, 58, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerber as applied to claims 39, 47, 56, and 61 above, and further in view of Bozich et al. US 6,748,285. Gerber does not explicitly disclose that the communications network is the Internet or that the at least one object comprises a plurality of different shaped objects. However, Bozich et al. discloses an integrated system for designing product packaging comprising a client-server Internet communications network (e.g., Fig. 1) and at least one packaging object comprising a plurality of different shaped objects (e.g., col. 7 line 32 – col. 8 line 37).

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Gerber and Bozich et al. are analogous art since both relate to packaging design systems. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gerber with Bozich et al. due to the well known advantages of the Internet and due to the commonality of packaging objects that are of a different shape, such as pre-cooked meals and potato chips, as taught by Bozich et al.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan A. Jarrett whose telephone number is (571) 272-3742. The examiner can normally be reached on 10:00-6:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on (571) 272-3749. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ryan A. Jarrett
Examiner
Art Unit 2125

RAJ
8/10/05


ALBERT W. PALADINI
PRIMARY EXAMINER